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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,086	01/10/2001	Richard L. Sandt	AVERP2822US	7421

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,086

Applicant(s)

SANDT ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13, 19 and 41 is/are rejected.
- 7) ☒ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/22/03 has been entered.

The indicated allowability of claims 1-19 has been withdrawn in view of the new references (Vorrier et al., Caines) found. Claims 14-18, drawn to a non-elected species, have been withdrawn since claim 1 is no longer allowable.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the radio frequency identification device defined in claim 10 and a layer of ink printed on the lower surface of the heat-activatable layer and a layer of ink or graphics printed on the lower surface of the detach layer as defined in claim 41 must be shown or the feature(s) canceled from the claim(s). With regard to claim 41, figure 5 only shows a single layer of ink on the detach layer. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

Claims 13, 19, and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is indefinite since stating that the detach layer is adhered to the lower surface of the heat-activatable and the indicia is positioned between the heat-activatable layer and the flexible substrate is inaccurate. The applicant clearly shows in figure 5 that the indicia is not between the heat-activatable layer and the flexible substrate in the embodiment which includes the detach layer. Claim 19 is indefinite since it not understood how the tie layer can between the heat-activatable layer and the facestock and still have the heat-activatable layer adhered to the lower surface of the facestock. In claim 41, line 8, is indefinite since the embodiment having the detach layer (fig. 5) clearly shows that the only indicia is printed on the bottom of the detach layer, i.e. no indicia is printed on the lower surface of the heat-activatable layer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Vorrier et al. (U.S. Patent No. 4,133,926).

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Vorrier et al. shows in the figure a tag assembly comprising a facestock (18), a heat-activatable layer (16), a flexible polymeric substrate (12), and identifying indicia (14) positioned between the heat-activatable layer and the flexible substrate. The polymeric substrate (12) is considered to be flexible since it is well known that credit cards (the device of Vorrier et al. is used to make credit cards) are somewhat flexible. Therefore, the substrate of Vorrier et al. has to be somewhat flexible. In regard to claim 4, the facestock (18) of Vorrier et al. is formed from a polymeric film, see column 4, lines 1-8. In regard to claims 8 and 9, Vorrier et al. shows in the figure that the indicia is on the lower surface of the heat-activatable layer and on the upper surface of the substrate.

Claims 1,2,4,8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Caines (U.S. Patent No. 4,557,963).

Caines shows in the figure a tag assembly comprising a facestock (18), a heat-activatable layer (16), a flexible polymeric substrate (12), and identifying indicia (14) positioned between the heat-activatable layer and the flexible substrate. The polymeric substrate (12) is considered to be flexible since it is well known that credit cards (the device of Caines is used to make credit cards) are somewhat flexible. Therefore, the substrate of Caines has to be somewhat flexible. In regard to claim 4, the facestock (18) of Caines is formed from a polymeric film, see column 3, lines 1-15. In regard to claims 8 and 9, Caines shows in the figure 2 that the indicia is on the lower surface of the heat-activatable layer and on the upper surface of the substrate.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vorrier et al. (U.S. Patent No. 4,133,926).

In regard to claim 3, Vorrier et al. shows in the figure a facestock (18) formed from a single layer. Vorrier does not disclose the idea of making the facestock out of two layers. It would have been an obvious matter of design choice to make the facestock out of two layers instead of one since the applicant failed to define any advantage to making the facestock out of two layers and making the facestock out of a single layer as taught by Vorrier et al. would work equally well. In regard to claims 5-7, Vorrier et al. does not disclose the use of the specific materials disclosed in these claims. However, the materials defined are conventional in the art and it would have been an obvious matter of design choice to make the layers out of the materials defined since the applicant failed to define any advantage to making the materials out of the materials defined and the materials used by Vorrier et al. would work equally well.

Claims 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caines (U.S. Patent No. 4,557,963).

In regard to claim 3, Caines shows in the figure a facestock (18) formed from a single layer. Caines does not disclose the idea of making the facestock out of two layers. It would have been an obvious matter of design choice to make the facestock out of two layers instead of one since

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the applicant failed to define any advantage to making the facestock out of two layers and making the facestock out of a single layer as taught by Caines would work equally well. In regard to claims 5-7, Caines does not disclose the use of the specific materials disclosed in these claims. However, the materials defined are conventional in the art and it would have been an obvious matter of design choice to make the layers out of the materials defined since the applicant failed to define any advantage to making the materials out of the materials defined and the materials used by Caines would work equally well.

Allowable Subject Matter

Claim 41 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 13 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Oct. 20, 2003